

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING  
IN RELATION TO A REQUEST BY REDENVELOPE INC (THE OPPONENTS)  
FOR AN EXTENSION OF TIME TO FILE EVIDENCE STRICTLY IN REPLY  
IN THEIR OPPOSITION (NUMBER 51367) TO  
APPLICATION 2205212 IN THE NAME OF RED LETTERS DAYS PLC**

## TRADE MARKS ACT 1994

### **IN THE MATTER OF an Interlocutory Hearing in relation to a request by Redenvelope Inc (the opponents) for an extension of time to file evidence strictly in reply in their opposition (number 51367) to application 2205212 in the name of Red Letter Days Plc**

1. At an Interlocutory Hearing on 21<sup>st</sup> March 2002 I refused a request for an extension of time for the opponent in this matter to file evidence in reply under Rule 13(10) of the Trade Marks Rules 2000. Written confirmation of the decision was issued to both parties to these proceedings on 22<sup>nd</sup> March 2002. A period of one month was given for either party to request a written statement of grounds for my decision.

2. On 27<sup>th</sup> March 2002 the opponent filed a form TM5 together with the appropriate fee (£100) requesting a written statement of grounds for my decision.

#### **Background**

3. Red Letter Days Plc have applied under application No. 2205212 to register:

RED LETTER

Red Letter

A handwritten logo for 'RedLetter' in a cursive, black ink style. The word 'Red' is written in a smaller font size than 'Letter', and they are joined together.

4. The application was made on 6<sup>th</sup> August 1999 for a variety of goods and services in Classes 9, 14, 16, 18, 21, 22, 25, 26, 33, 36, 39, 41 & 42. Following examination of the application, the mark was published in the Trade Marks Journal on 31<sup>st</sup> May 2000. On 1<sup>st</sup> September 2000, Redenvelope Inc filed a notice of opposition and statement of grounds against this application.

5. The applicant filed its defence, by way of Form TM8 and counterstatement, on 3<sup>rd</sup> January 2001. The opponent was accordingly set a three month period, up to and including 8<sup>th</sup> April 2001, in which to file evidence in support of its opposition under Rule 13(7). The opponent sought a three month extension (up to 8<sup>th</sup> July 2001) to this period. This was granted, albeit following a preliminary refusal by the Trade Marks Registry coupled with a request for additional information. A second extension, this time for a three week period, was then received and granted up to 29<sup>th</sup> July 2001. The opponent's evidence under Rule 13(7) was subsequently received on 27<sup>th</sup> July 2001.

6. The applicant was then, under Rule 13(9), given a three month period, up to and including 27<sup>th</sup> October 2001, in which to file evidence in support of its application for registration. The applicant's evidence was received within that period prescribed under Rule 13(9). The opponent was then, under Rule 13(10), given a three month period, up to and including **25 January 2002** in which to file evidence strictly in reply to that filed by the applicant.

7. On 25<sup>th</sup> January 2002 the opponent filed a Form TM9 (and fee) in which they requested an extension of time of three months. The reasons given were:

“This request is filed as more time is needed to consider and analyse the evidence filed by the applicant. Consideration is given to the manner in which the opponent is to respond in its evidence in reply. The opponent is also considering responding to the evidence filed by the applicant by filing further evidence. Discussions are being held between the opponent and its agents on the manner in which relevant evidence may be obtained and further information be used in the evidence in reply. Therefore, more time is also needed to fully prepare the opponent’s evidence in reply.

In the meantime, the opponent is seeking to resolve this matter in an amicable manner. The Chief Executive Officer of RedEnvelope Inc is currently in contact with the Managing Director of Red Letter Days Plc to discuss a way to resolve this matter amicably.

We believe it is in the mutual interests of the parties to be given further time to explore reaching an amicable solution without escalating the dispute and incurring further expense. The interests of the parties in reaching such an agreement must ultimately be in the overriding interest of justice.

On the basis of the above, we request for an extension of time of three months, until **25 April 2002**, to respond to the evidence in reply.”

8. The Trade Marks Registry took the preliminary view that the above reasons were sufficient to allow the additional time sought by the opponent. This preliminary decision was notified to the parties on 30<sup>th</sup> January 2002, a period of 14 days was allowed for the applicant to comment.

9. By way of letter dated 5<sup>th</sup> February 2002 the applicant objected to the granting of the extension of time. In summary, the applicant stated that the opponent had not fully utilised the three month period that they had been given, concern was raised at the reference to the prospective filing of “further evidence”; the contact made to settle the dispute was only made shortly before the expiry of the set deadline and that this should not delay the present proceedings. They also stated that given the fact that the opponent had been granted additional time when filing their evidence in chief, this was disproportionate to the amount of time that the applicant had had to put together their evidence, and that in the interests of fairness the extension should not be granted.

10. Despite the applicant’s objection to the request for additional time, the Registry maintained its preliminary view to grant the extension of time. The applicant was given until 13<sup>th</sup> February 2002 in which to request a hearing under Rule 54(1). On 11<sup>th</sup> February 2002 the applicant made such a request.

11. In accordance with the applicant’s wishes, an Interlocutory Hearing was arranged for the matter to be decided. The Hearing took place before me, via a video conference link, on 21<sup>st</sup> March 2002. Mr Michiner of Field Fisher Waterhouse represented the opponent and Mr Fiddes of DLA Trademarks represented the applicant for registration.

12. During the hearing both representatives gave detailed submissions directed at the reasons for and against the granting of an extension in this matter. Submissions were also received as to the approach that I should take when reaching my decision. I will refer to these submissions, as and when necessary, during the course of this written decision. I also

received skeleton arguments from both sides prior to the hearing, I will again refer to these as and when necessary.

## **Decision**

13. The discretionary power to extend time periods is provided for in Rule 68 of the Trade Mark Rules 2000, the relevant parts of which read:

**68.** - (1) The time or periods-

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or

(b) specified by the registrar for doing any act or taking any proceedings,

subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

(2) Where a request for the extension of a time or periods prescribed by these Rules-

(a) is sought in respect of a time or periods prescribed by rules 13, 18, 23, 25, 31, 32, 33 or 34, the party seeking the extension shall send a copy of the request to each person party to the proceedings;

(b) is filed after the application has been published under rule 12 above the request shall be on Form TM9 and shall in any other case be on that form if the registrar so directs.

(3) The rules excepted from paragraph (1) above are rule 10(6) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rules 13(3) and 13(5) (time for filing counter-statement), rule 13(4) (cooling off period) save as provided for in that rule, rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(2) (time for filing counter-statement), rule 32(2) (time for filing counter-statement), rule 33(2) (time for filing counter-statement), and rule 47 (time for filing opposition).

(4) Subject to paragraph (5) below, a request for extension under paragraph (1) above shall be made before the time or period in question has expired.

(5) Where the request for extension is made after the time or period has expired, the registrar may, at her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her to be just and equitable to do so.

14. I considered that the extension of time request filed by the opponent on 25<sup>th</sup> January

2002 satisfied (in so far as meeting the formalities for filing) the provisions of Rule 68 above. The extension sought is in respect of evidence in reply under Rule 13(10) and as such is not a period excepted by Rule 68(3). The request was also filed on time, had been copied to the other side and was accompanied by the appropriate fee.

## **The Law**

15. Both parties referred me to various authorities relevant to the determination of requests for extensions of time. On the one hand I was told that my discretion is broad and that I can consider any relevant circumstance to justify the grant of an extension of time (*Liquid Force BL 0/123/98*); on the other hand I was told that I must be satisfied with regard to what has been done, what is intended to be done and why it was not done (*Siddiqui's Application BL 0/481/00*).

16. In general terms both sides are correct. Both lines of argument are clearly supported by the case law to which I was referred. However, I am conscious of the decision of Mr Simon Thorley QC sitting as the Appointed Person in *Siddiqui's Application* where he states:

*“Accordingly, it must be incumbent on the applicant for the extension to show that the facts merit it. In a normal case this will require the applicant to show clearly what he has done, what he wants to do and why it is that he has not been able to do it. This does not mean that in an appropriate case where he fails to show that he has acted diligently but that special circumstances exist an extension cannot be granted.”*

17. Taking the case law in the round, I consider that I must firstly look to the *Siddiqui* criteria and decide, based on the information gained from applying this criteria, whether the extension of time may be granted. However, even if the requestor fails on the *Siddiqui* criteria, I am not prevented from granting the extension if there are any special circumstances that I consider relevant to justify the extension sought.

18. Both sides also referred me to the overriding objective set out in the Civil Procedure Rules and to the reforms recommended by Lord Woolf in his review of civil justice. Mr Fiddes reminded me of the recommendation to deal with cases in an expeditious manner, whilst Mr Michiner reminded me that this should not be done to the detriment of one side simply for the sake of speed. I do not feel I need to say a great deal other than to re-enforce the fact that this tribunal adheres to the same overriding objective as the court for dealing with cases justly, as set out in rule 1.1 of the Civil Procedure Rules 1998. This includes dealing with cases in both an expeditious and fair manner. It is with this in mind that I approach my decision

## **The Siddiqui Criteria**

19. To succeed under this criteria, the opponent must clearly show what he has done, what he wants to do and why it is that he has not been able to do it. I must therefore consider to what extent the opponent has met the criteria and whether this determines the request in its favour.

20. **What he has done?** - The reasons put forward with the request for additional time do not clearly show what the opponent has done. It is stated that *“more time is needed to*

*consider and analyse the evidence filed by the applicant. Consideration is given to the manner in which the opponent is to respond in its evidence in reply.” and “Discussions are being held between the opponent and its agents on the manner in which relevant evidence may be obtained and further information be used in the evidence in reply”. The skeleton argument of the opponent adds that “The evidence filed by the applicant was voluminous. A large amount of time was expended to pursue, consider and analyse all evidence filed”*

21. From the above it seems likely that the opponent has expended some time in considering and analysing the evidence filed by the applicant, but it would appear that at the end of the statutory period this task was not complete, hence more time being required to “*consider and analyse the applicants evidence*”. The request also explains that consideration is being give to the manner in which to respond. Mr Michiner, in his submissions, said that this consideration was aimed at countering some of the statements in the applicant’s evidence, and for which research would be required.

22. **What he wants to do?** - The original request essentially states that the opponent wishes to continue with their consideration and analysis with a view, presumably, of filing the evidence in reply. Mr Michiner referred to the research that was necessary to counter what he termed “ambiguities” in the applicant’s evidence, but no detail was provided as to when this research started, or if it had started at all. No information was provided as to the nature of this research or to the length of time that this research would take. No information was provided as to how long thereafter it would take to compile and furnish the evidence in reply.

23. **Why it is that he has not been able to do it?** – Again, it has not been clearly explained why these tasks were not carried out during the 3 month period allowed by the Rules. The only reason I can reasonably take into account is the opponent’s claim that the applicant’s evidence was voluminous and therefore a “*large amount of time had been expended to peruse, consider and analyse all evidence filed*”. With regard to the research to which Mr Michiner referred, there is no explanation as to why, if it had not commenced, it could not have been done so during the relevant period.

24. First of all on the volume of the applicant’s evidence. It would not, in my opinion, be reasonable to hold that it was voluminous. It consists of two statutory declarations, the first being a little over five pages long, the second being three and a half pages long. The first declaration has appended to it two exhibits, they consist of details of one of the opponent’s US Trade Mark Registrations and one of its domain name registrations. The second declaration has a single exhibit appended to it, this consists of examples of the applicant’s publicity material. Thus perusal and analysis would have required a period of time, but not a period of time sufficient to delay the filing of the evidence in reply.

25. Furthermore, even if the opponent had begun the “research” to which Mr Michiner referred during the statutory period, no reason has been provided as to why this task could not have been completed. Research is often necessary during the compilation of evidence and is in most cases carried out during the prescribed periods. In this case I have not been provided with any details of what research was considered necessary, how long it would take, or how long it would take to compile it into evidence. No reason has been adduced therefore as to why and how the opponent was presented with particular difficulties which might depart from the normal difficulties faced by parties filing evidence.

26. The reasons put forward in support of the extension of time did not clearly address the criteria laid down in Siddiqui's Application; the skeleton arguments and submissions did not take me any further forward. I could not, of course, have invited the opponent to give further reasons or expand their existing reasoning at the hearing given that the hearing must be confined to the reasons already put forward in writing (see the decision of Mr Hobbs QC sitting as the Appointed Person in *Style Holdings case BL 0/464/01*).

27. In Siddiqui's Application, Mr Simon Thorley QC states that:

*“Jacob J made it clear in the SAW case that any perception that the registrar would grant extensions liberally was wrong and I take this opportunity to repeat that. In principle matters should be disposed of within the time limits set out in the Rules and it is in an exceptional case rather than the normal case where extensions will be granted.”*

28. The provision for filing evidence in reply is governed by Rule 13(10). This provides a three month period for the filing of evidence in reply. This three month period must necessarily envisage that in a normal case the opponent will need to consider the applicant's evidence, decide what to file in response, and to collate and file it. As already mentioned, I do not consider that the applicant's evidence was so voluminous, as the opponents state, as to suggest that this was an exceptional case. As for the research, as I have been given no details I am unable to give that factor much, if any weight.

29. I also took into account the fact that the hearing took place almost two months after the expiry of the initial three month period. No evidence, or even draft evidence, was placed before me at the hearing. Neither were any submissions made, or attempted to be made, as to the current state of the research that was to be undertaken or the resulting analysis. There was therefore no information on the state of play of the proposed evidence, or that the evidence in reply would be filed within the requested time.

30. In view of the above, I do not consider that the opponent has demonstrated sufficient reason why the discretion provided by Rule 68 should be exercised in their favour. However, that is not the end of matters, as I may nevertheless grant the extension if there are any special circumstances to justify the grant of the extension.

### **Any Special Circumstances?**

31. Mr Michiner did not make any specific claim that “special circumstances” existed to warrant the granting of the extension. The only factor that has not already been mentioned and that I could possibly consider to be special circumstances is that of “negotiations”. The issue of negotiations was not pressed greatly at the hearing, but was covered by both parties in their skeleton arguments and was put forward by the opponent in its original request for additional time.

32. It is clear from both sides submissions that the settlement negotiations were no more than an offer, by the opponent, to meet to see if there was a way to amicably resolve the dispute. Mr Fiddes pointed out that the offer of this meeting was made only shortly before the expiry of the statutory period, and furthermore that the applicant's position had been one of pessimism as the applicant could not envisage an amicable solution being reached.

33. The contact between the parties had been superficial. No negotiations were taking place or had taken place. This form of contact should not and could not be regarded as a special circumstance sufficient to delay the proceedings or relieve a party of their obligation to file evidence. Had it been intended by both parties to pursue negotiations on a serious footing, they could have requested a stay in proceedings.

### **Conclusion**

34. Taking all the factors into account, I do not believe that the opponent has demonstrated sufficient reasons for, or any special circumstances to justify the extension they sought. The opponent instigated these proceedings and as such should have been prepared to prosecute them in the manner required by the Rules. The opponent's request for additional time stands refused.

### **Consequences**

35. The consequence of this decision is that the evidential rounds of this opposition action are complete, the case now being ready for substantive decision.

### **Costs**

36. Any issue of costs was deferred to be dealt with at the conclusion of proceedings.

**Dated this 17<sup>TH</sup> Day of May 2002**

**Oliver Morris  
For the Registrar  
The Comptroller-General**